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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,722	12/28/2001	Lester Benjamin Johnson	87354.1581	4118
36734 7590 05/12/2009 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304				
EXAMINER				
RUHL, DENNIS WILLIAM				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
05/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/028,722

Applicant(s)

JOHNSON ET AL.

Examiner

Dennis Ruhl

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/25/09 has been entered.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 and 5 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter

that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because the claims do not contain a tie to a particular machine. The step of entering vehicle identification information into a computerized system, is not a recitation to a particular machine and at best is considered to be extra solution activities in the form of mere data gathering or data entry. The same is concluded for the limitation of receiving information directly from diagnostic equipment, this is considered to be the use of a machine for extra solution activities in the form of data gathering or data receipt. The steps of comparing, determining, identifying, determining, and displaying are not tied to any machine at all. The only alleged tie found in the claims is directed to extra solution activities, and is directed to the mere use of a generic machine and not the use of a particular machine as is required under the machine transformation test.

Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,5,6,10,11,15-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808) in view of Kirkevold et al. (6263322).

The applicant should take notice that in the system claims, the mechanic is not present in the claim scope. The mechanic is referred to in a functional sense as far as the intended user of the various claimed elements. For the system claims, the person that is intended to be the one that enters the data is not part of the claim scope so reciting that it is a mechanic that is to enter information and that it is the mechanic that is the one that is supposed to operate the diagnostic equipment is not further defining any structure to the system as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A

mechanic is fully capable of operating the claimed elements, so the prior art satisfies what is claimed as will be explained below. Additionally, the prior art satisfies what is claimed with respect to the operation of the diagnostic equipment as will be explained.

For claims 1,6,11,20,21,23-26,28,29, Li discloses a system and method for providing vehicle information. Li discloses a system where a user (vehicle owner or automotive repair shop service associate, any user) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong with the vehicle. A service solution is determined as claimed. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem (is problem covered under warranty, yes or no, see figure 11 of Li). See figure 17 and paragraph 61 where it is disclosed that vehicle identification information is entered. The "means for entering the vehicle identification information" is satisfied by the computer interface 80 that allows entry of the claimed type of data. Figure 17 shows the VIN number being entered, which identifies the vehicle. The vehicle problem information entered into the system by the user is the claimed diagnostic information, which is analyzed to arrive at a service solution. See paragraph 42 for a disclosure of comparing the received diagnostic information to a symptoms database 90 to determine a prognosis. The "means for comparing" the received diagnostic information with reference information is module 30, that compares received vehicle diagnostic information to a symptoms database to determine a prognosis. This module 30 also satisfied the claimed "means for identifying at least one service solution. The results are then displayed as claimed, which also satisfies the claimed "means for displaying",

which is just a display. Databases are used to store the data (for claim 11). Also, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions, this satisfies the claimed *"means for identifying if the at least one service solution is covered under warranty"*.

Not disclosed by Li is that the diagnostic information is received *"directly from diagnostic equipment"*. In Li the data is entered manually and applicant is claiming a situation that is representative of an automated collection of vehicle diagnostic data. Also not disclosed for only claim 1 is that the vehicle identification information is entered by a mechanic.

Kirkevold discloses an auto repair shop computer system that manages just about every aspect of a repair shop that one can think of. It is specifically disclosed that the computer system includes *diagnostic* equipment (see figure 1, #1,12,14,16) that analyzes data taken from vehicles *to diagnose a problem*. For example see column 9, line 56 to column 10, line 18. The operator of the diagnostic equipment satisfies the claimed limitation of a mechanic, which is really just a title and is only defining a person. Clearly in the reference it is a repair technician (mechanic) that is operating the diagnostic equipment and repairing the vehicles. Kirkevold is disclosing the fact that is it well known in the auto repair art to take vehicle data directly from vehicle analyzer components 52, that are connected to a vehicle by the repair technician (which is a mechanic and satisfies what is claimed). In Kirkevold, the diagnostic data that is used to diagnose the vehicle problem comes directly from diagnostic equipment that is connected to the vehicles (see figure 1). Also, the examiner notes that Kirkevold

recognizes that Diagnostic Trouble Codes can be retrieved from the on board computer of a vehicle, see column 11, lines 49-51. The on board computer satisfies an onboard monitoring system as is claimed in claim 21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li so that data concerning vehicle problems can be received directly from the diagnostic equipment that is operated by a repair technician (mechanic), as is taught by Kirkevold. This is very well known to one of ordinary skill in the art. The receipt of data directly from diagnostic equipment would be desirable because it allows for more complex troubleshooting to occur, such as the obtaining of data by the various devices disclosed by Kirkevold (engine analyzer, alignment analyzer, brakes analyzer, etc.) that allow for more complex problem analysis than the system of Li can provide with just user objective input. A repair technician (mechanic) would use diagnostic equipment connected to the vehicle, like the disclosed engine analyzer of Kirkevold. The repair technician (mechanic) could also connect to the vehicle's on board computer to obtain error codes (as is disclosed by Kirkevold) and this would then allow problem diagnosis to occur based on the received data. One of ordinary skill in the art would have found it obvious to collect the diagnostic data directly from diagnostic equipment that is operated by a mechanic so that a more accurate diagnosis can occur.

With respect to the claimed entering of the vehicle identification information by a mechanic, Li discloses that a person enters this same information. It may be a customer or it may be an automotive repair shop service associate. The entering of the vehicle information can be done by anyone, it does not matter who is doing it. Because

the rejection results in the vehicle diagnostic information being taken from diagnostic information operated by a mechanic, it would make sense that somebody such as a mechanic at the repair shop would also enter the vehicle identification information. The examiner also notes that it does not appear to matter who it is that enters the data. The method does not depend on a specific individual entering the information and the invention would perform the same if a person other than a mechanic entered the vehicle identification information. The specification does not disclose that having a mechanic enter the vehicle identification information solves any particular problem or that this produces any unexpected result. It also makes sense that if an automotive repair shop service associate is able to enter the information that it would have been obvious to try and have a mechanic also enter the information (maybe the service associate is out sick that day). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mechanic enter the vehicle identification information for the above reasons.

For claims 5,10,15, not disclosed is that the entered vehicle identification information is the make, model, and year of the car. In Li, it is disclosed that the VIN (vehicle identification number) is entered. The VIN number represents the make, model, year, and options that the vehicle has. One of ordinary skill in the art would readily appreciate this fact and would have found it obvious to have the vehicle identification information that is entered be the make, model, and year, as claimed. Li discloses the entering of vehicle ID data and modifying Li to accept the make, model,

and year, as opposed to the VIN number, is something that one of ordinary skill in the art would have found obvious.

For claims 22,27, Kirkevold discloses the use of hand held diagnostic equipment, such as equipment 5 and 6 as shown in figure 1. the 103 combination also includes these features as being provided to Li. The 103 combination is providing Li with the ability to collect data from the various devices disclosed by Kirkevold.

For claims 16,17, not disclosed is that Li is configured to receive information (diagnostic and vehicle identification information) wirelessly. Li discloses in paragraph 40 that various communication networks can be used, "or other networking technologies" (i.e. LANs, WANs, global networks). Wireless transmission of information is something that is old and well known in the art. One of ordinary skill in the art would certainly be aware of the fact that there are wireless networks in existence where data can be transferred wirelessly. This is something that one of ordinary skill in the art would be aware of as of the effective filing date for this application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with wireless data communication ability, so that the data could be transferred by wireless communication, as is well known in the art.

For claims 18,19, not disclosed is that the data input is configured to use the TCP/IP protocol. The TCP/IP protocol is something that is well known to one of ordinary skill in the art. This type of data transfer protocol was developed many years ago and is something that one of ordinary skill in the art would be very aware of. It would have been obvious to one of ordinary skill in the art at the time the invention was

made to provide the data input of Li with the TCP/IP protocol. In view of the fact that in Li a user can interact with the system from home via computer, one of ordinary skill in the art would recognize that the TCP/IP protocol would be desirable, especially because this kind of protocol is used extensively for the Internet.

6. Applicant's arguments filed 1/4/08 have been fully considered but they are not persuasive.

Applicant has argued that Li is not designed to take data directly from vehicles, and that Li requires manual entry of information into the system to form a pre-diagnosis, so Li cannot satisfy the taking of information directly from diagnostic equipment, etc.. This argument is ignoring the fact that the examiner has used a secondary reference to Kirkevold, which provides automated taking of diagnostic information to Li. Li has been modified in the 103 rejection to do what applicant has stated Li does not disclose. This argument is not persuasive. Then applicant simply alleges that the combination as set forth by the examiner does not satisfy what is claimed. The only argument seems to be an attack on Li individually and not in the combination set forth in the prior art rejection of record. The arguments are not persuasive.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689